

**REMARKS**

Applicants hereby traverse the outstanding rejections, and request reconsideration and withdrawal in light of the amendments and remarks contained herein. Claims 1-40 are pending in this application

**Cross References**

The Office Action requests updates of the current status of the referenced applications. The referenced applications at pages 1 of the specification are currently pending and, therefore, require no updated information. Thus, Applicants believe that the request of the Examiner has been satisfied.

**Objection to the Disclosure**

The disclosure stands objected to for including an embedded hyperlink on pages 6-7. In response, Applicants have deleted the hyperlink. Thus, Applicants believe that the objection to the disclosure has been overcome, and that this objection should be withdrawn.

**Rejection under 35 U.S.C. § 112, second paragraph**

Claims 1-32 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Specifically, the words “the time duration” in claims 1 and 24 lack antecedent basis. Also, the Office Action states that it is unclear how production data relates to production device and production options.

With regard to the lack of antecedent basis, the Applicants have amended claims 1 and 24 to provide antecedent basis for the words “time duration”. The claims have been amended only for the purpose of complying with the requirements of 35 U.S.C. § 112, second paragraph, and not for the purpose of narrowing their scope in the face of prior art. No new matter has been entered.

With regard to production data, production device, and production options, Applicants respectfully assert that their relationships are clearly defined in the claims. For example, claim 1 defines “...from a first user’s browser, accessing a destination service representing a production device; b. retrieving production data of said first user by said destination service; c. at said first user’s browser, selecting production options from among a plurality of

production options provided by said destination service for determining a first processing job for processing said first user's production data using said production device;". Applicants believe that this passage adequately defines the relationships of production data, production device, and production options, and that no further description is necessary.

As each element of indefiniteness cited by the Office Action has been addressed with a corresponding amendment or argument, Applicants respectfully request the rejection of claims 1-32 under 35 U.S.C. § 112, second paragraph be withdrawn

### **Rejection under 35 U.S.C. § 103**

Claims 1-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Takuwa et al. ('229, hereinafter Takuwa) in view of Grout ('033), further in view of Barth et al. ('873, hereinafter Barth).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criteria, Applicants assert that the rejection does not satisfy the first and third criteria.

### **Lack of Motivation**

The Office Action admits that Takuwa does not teach having the various limitations cited in paragraph 8 of the Office Action.. The Office Action attempts to cure this deficiency by introducing Grout, which the Office Action alleges to teach having such limitations. The motivation for making the combination was presented as follows:

"It would have obvious ... to combine the teachings of Takuwa and Grout because Grout's first user's browser... would provide an enhanced document manager to Takuwa's system, therefore it will increase performance. "

It is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. § 2143.01. The first portion of the sentences is merely the result of combining Takuwa and Grout. The second portion, namely “it will increase performance” is not apparent from the combination. Takuwa discloses a system that allows a first print job to be interrupted and allow a second print job to print, if the first print job is taking too long to print, see the Abstract of Takuwa. Grout teaches a method of retrieving information using objects having links embedded in a document. Thus, it is not apparent how the teaching of Grout will increase the performance of Takuwa. Consequently, the supplied language is merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification. The motivation cited in combining Barth with Takuwa and Grout does not cure the deficiency of the motivation in combining Takuwa and Grout.

No valid suggestion has been made as to why a combination of Takuwa and Grout is desirable. Therefore, the rejection of claims 1-33 should be withdrawn.

#### Lack of Elements

The Office Action admits that Takuwa does not teach having the various limitations cited in paragraph 8 of the Office Action.. The Office Action attempts to cure this deficiency by introducing Grout, which the Office Action alleges to teach having such limitations. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Claim 1 defines a method that includes at said first user’s browser, selecting production options from among a plurality of production options provided by said destination service for determining a first processing job for processing said first user’s production data using said production device. The Office Action admits that Takuwa does not disclose this

limitation. The Office Action relies on Grout as teaching this limitation, specifically the text at col. 3, lines 24-28, col. 7, lines 31-40, and col. 8, lines 1-3. Grout does not disclose at least this limitation. Col 3, lines 24-28 discuss the parsing by the document manager of an embedded link. Col. 7, lines 31-40 discusses the parsing of a downloaded document by the browser. Col. 8, lines 1-3 discuss the user selection of the language or culture in which the document may be viewed. Thus, Grout does not teach the claimed invention. Barth is not relied upon as teaching this limitation. Therefore, the Applicants respectfully assert that for the above reasons claim 1 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim 24 defines a destination service that is operable to select under said first user's interactive control via said content from among production options for processing said first user's production data using said production device. The Office Action admits that Takuwa does not disclose this limitation. The Office Action relies on Grout as teaching this limitation, specifically the text at col. 3, lines 24-28, col. 7, lines 31-40, and col. 8, lines 1-3. Grout does not disclose at least this limitation. Col 3, lines 24-28 discuss the parsing by the document manager of an embedded link. Col. 7, lines 31-40 discusses the parsing of a downloaded document by the browser. Col. 8, lines 1-3 discuss the user selection of the language or culture in which the document may be viewed. Thus, Grout does not teach the claimed invention. Barth is not relied upon as teaching this limitation. Therefore, the Applicants respectfully assert that for the above reasons claim 24 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claims 2-23 and 25-33 depend from base claims 1 and 24, respectively, and thus inherit all limitations of their respective base claim. Each of claims 2-23 and 25-33 set forth features and limitations not recited by the combination of references. Thus, the Applicants respectfully assert that for the above reasons claims 2-23 and 25-33 are patentable over the 35 U.S.C. § 103(a) rejection of record.

### **Rejection under 35 U.S.C. § 103**

Claims 34-40 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hisatake et al. ('356, hereinafter Hisatake) in view of Grout.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second and third criteria, Applicants assert that the rejection does not satisfy the first criteria.

#### Lack of Motivation

The motivation provided for this rejection combines Takuwa and Grout, and does not discuss the combination of Hisatake and Grout.

No valid suggestion has been made as to why a combination of Hisatake and Grout is desirable. Therefore, the rejection of claims 33-40 should be withdrawn.

#### Conclusion

For all the reasons given above, the Applicants submit that the pending claims distinguish over the prior art of record under 35 U.S.C. § 103. Accordingly, the Applicants submit that this application is in full condition for allowance.

Applicants respectfully request that the Examiner call the below listed attorney if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Application No.: 10/001,551

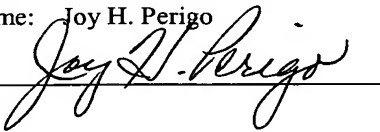
Docket No.: 10008251-1

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10008251-1 from which the undersigned is authorized to draw.

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